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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,834	12/08/2000	Neil A. Willcocks	2280.2680	1867
5514	7590	04/17/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/731,834

**Applicant(s)**

WILLCOCKS ET AL.

**Examiner**

Raquel Alvarez

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30,32 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30,32 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/20/04, 11/18/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 11/28/2005.
2. Claims 1-30, 32, 36-39 are presented for examination.

#### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-30, 32, 36-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (6,336,099 hereinafter Barnett).

With respect to claims 1-4, 6-11, 14-19, 21, 23-27, 29-30, 32, 36, 37, 38, 39 Barnett teaches a method for motivating a consumer to promptly indicate an interest in purchasing a product and/or service over a computer network (Figure 1). Providing from a server over the computer network to a consumer's computer a program that causes the computer to present to said consumer an offer for sale of a product and/or service that may be purchased immediately by said consumer via the computer network (Figure 1); concurrently present to said consumer an incentive for purchasing said product and/or service promptly, wherein the program causes said incentive to be initially set to a first non-zero an initial value and then changes said incentive over a period of time to at least one other value (i.e. the incentive starts with a value and then

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the value can change (i.e. coupon starts with a value and over the time the On-line provider can change the value of the coupon)(col. 12, lines 9-16); when said consumer indicates an acceptance of the offer, provide to the server an indication of acceptance and a current value of said incentive (Figure 1, 4); registering at the server an initial time at which said incentive is initially presented to said consumer (i.e. the demographic data file 42 contains data representative of the demographic inquiries presented to the user at the time that the user requests a download of coupon data from the coupon package data file 40, as well as data representative of the users' response thereto); registering at the server an acceptance time at which said consumer indicates an acceptance of the offer (i.e. the demographic data file 42 contains data representative of the demographic inquiries presented to the user at the time that the user requests a download of coupon data from the coupon package data file 40, as well as data representative of the users' response thereto); and comparing the initial time and the acceptance time to verify the provided current value of said incentive (i.e. the time when the coupon is presented to the user and the time when the coupon is printed is compared if a long time has passed. Eg. A month , then the coupon value is decreased to 0)(col. 11, lines 66 to col. 12, lines 1-8); providing said consumer the current value of said incentive, if the current value of said incentive is verified (i.e. if the time hasn't expired then the consumer is presented with the current value of the offer) (col. 11, lines 66 to col. 12, lines 1-8) the incentive presented via a web page (Figure 8).

With respect to figure 12, Barnett further teaches wherein a consumer who frequently uses said incentive for purchasing products and/or services is accorded a more favorable incentive than a consumer who frequently uses said incentive to purchase goods and/or services (col. 12, lines 48-54).

With respect to claim 13, Barnett further teaches wherein said frequent consumer is accorded a higher maximum incentive value (col. 13, lines 30-42).

With respect to claim 20, Barnett further teaches wherein said information relates to a location of said consumer (see claims 5 and 31 Of Barnett).

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett.

Claim 5 further recites that the incentive is presented via a web banner. Official notice is taken that it is old and well known to present advertisements or the like on web banners. A web banner or banner ad is a form of advertising on the World Wide Web. This form of online advertising entails embedding an advertisement into a web page. It is intended to attract traffic to a website by linking them to the web site of the advertiser.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included presenting the incentive via a web banner in order to obtain the above mentioned advantage.

**Response to Arguments**

7. Please re-submit, copy of PTO-1449 dated September 5, 2001. In order for Examiner to initial International Publication no. WO 99/11343.

8. Applicant argues that Barnett doesn't teach presentation of an offer for sale of a product and/or service that may be purchased immediately via a network. The examiner disagrees with Applicant because in Figure 1 of Barnett, the user can redeem the coupons or offers Online through checkout 10. The purchase is done immediately via the network.

9. Applicant argues that Barnett doesn't teach variable incentive. The Examiner disagrees with Applicant because Barnett teaches on col. 12, lines 9-16 that the coupon starts with a value and over the time the On-line provider can change the value of the coupon. Also, Barnett teaches on col. 11, lines 66 to col. 12, lines 1-8 that the coupon or incentive value can be changed if the user doesn't redeem the offer within a predetermined time. The incentive changing from a maximum value to a minimum value of 0.

**Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

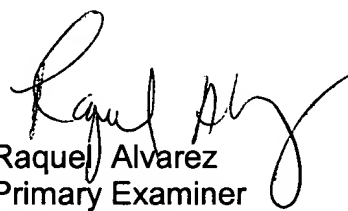
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of contact**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
3/30/2006